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specification at page 3, lines 12-23. Further support for new claim 21 may be found, inter alia, in claim 13 as originally filed.

Support for new claims 22-27 may be found, inter alia, in the specification at page 8, line 16 through page 11, line 15.

Accordingly, applicants respectfully request that the Amendment be entered.

#### **Claim Objections**

On page 2 of the December 6, 2000 Office Action, claims 19 and 20 were objected to under 37 C.F.R. 1.75(c) because they were dependent upon canceled claim 5. The Examiner stated that it appears that these claims should be dependent upon claim 18.

Since claims 19 and 20 have been canceled hereinabove, the objection is now moot.

#### **Rejection under 35 U.S.C. § 112, first paragraph**

On page 2 of the December 6, 2000 Office Action, claims 14-20 were rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner stated that independent claim 14 contains limitations not described by the specification as originally filed. The Examiner further stated that the claim states that "the SP (solubility parameter) value of said solvent being

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adjusted to control the particle diameter of toner particles based on a difference between the SP value of the resin itself and the SP value of the solvent."

The Examiner also stated that the basis for this limitation appears to be derived from pages 3 and 8 of the specification. The Examiner stated that page 3 of the specification states that the thermoplastic resin is dispersed "in a solvent having a high temperature dependency in its capability of dissolving the thermoplastic resin and having its solubility parameter adjusted for controlling the size of the toner particles." The Examiner further stated that page 8 of the specification goes into more detail concerning the solubility parameter, stating "a differential SP value ( $\Delta$ SP) between the SP value of the resin itself and that of the solvent should be as small as possible for diminishing the toner particle diameter." The Examiner also stated that the passage on page 3 does not address the solubility parameter of the resin, only that of the solvent. The Examiner further stated that on page 8, the specification relates the difference between the resin and solvent solubility parameters as being "as small as possible" to diminish the toner particle diameter. The Examiner stated that this is the only passage in the specification that addresses the difference in resin and solvent solubility parameter.

The Examiner also stated that the new claims include within their scope the situation where the difference in solubility parameters is other than small (e.g., large) and where the particle diameter control is such that the toner particle diameter is other than a "diminished" one (e.g., larger). The Examiner further stated that the specification fails to describe these other

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that reduces or eliminates a static charge while a charge controller includes a compound that increases or otherwise modifies a charge (e.g., changes the charge polarity; see Diamond § 6.2.3). The Examiner stated that the terms are not synonymous and "charge controller" is broader than "antistat".

Since claims 14-20 have been canceled hereinabove, the objection of those claims is now moot. It is submitted that new claims 21-27 recite subject matter that is adequately supported by and described in the specification.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

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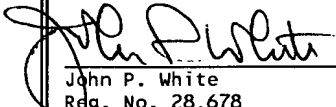
No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:  
Assistant Commissioner for Patents,  
Washington, D.C. 20231.



John P. White  
Reg. No. 28,678

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Date

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characteristics included within the scope of the claims. The Examiner stated that the specification language may not be suitable to meet the requirements of §112, second paragraph, if the claims are amended to adopt the limitation of the specification.

The Examiner also stated that the specification as filed also fails to describe the thermoplastic resin as being melted, as presented in claim 14. The Examiner further stated that heating of a thermoplastic resin does not necessarily result in melting. The Examiner stated that, for example, the thermoplastic resin could be softened, but not actually melted. The Examiner requested that, if there is basis in the specification for melting of the resin, applicants refer the Examiner to the appropriate page and line of the specification.

The Examiner also stated that the specification does not appear to describe the addition of inorganic fine particles "so as to permit toner particle precipitation". The Examiner further stated that, although the particles are added before particle precipitation, the specification does not appear to describe the inorganic fine particles as permitting toner particle precipitation. The Examiner requested that, if there is basis for the claim language, applicants refer the Examiner to the appropriate page and line in the specification.

The Examiner also stated that new claims 18 and 19 are not described by the specification because the specification does not disclose a "charge controller". The Examiner further stated that the specification does describe an "antistat" (page 9-10), and it appears that "antistat" is limited to a specific component